

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 24

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte GUANGRONG ZHANG, CHENG-ZHI YU,  
SHENG-HUI SU, KRISHAN L. KALRA,  
and DING ZHOU

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Appeal No. 1997-2745  
Application No. 08/212,175

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ON BRIEF

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Before WINTERS, WILLIAM F. SMITH, and ADAMS Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

**DECISION ON APPEAL**

This appeal was taken from the examiner's decision rejecting claims 2 and 4 through 21, which are all of the claims remaining in the application.

**REPRESENTATIVE CLAIMS**

Claims 18, 20, and 21, which are illustrative of the subject matter on appeal, read as follows:

18. A process for removing wax from a wax-embedded biological tissue specimen, said process comprising contacting said wax-embedded tissue specimen with a dewaxing composition comprising a paraffin-solubilizing organic solvent selected from the group consisting of aromatic hydrocarbons, terpenes and isoparaffinic hydrocarbons, a polar organic solvent, and a surfactant to solubilize the wax associated with the specimen.

20. A dewaxing kit for removing wax from a wax-embedded biological tissue specimen comprising:

- a receptacle adapted to hold individual reagent containers,
- a first container containing a dewaxing composition comprising
  - a) a paraffin-solubilizing organic solvent selected from the group consisting of aromatic hydrocarbons, terpenes and isoparaffinic hydrocarbons, comprising from about 25% to about 75% by volume of said composition;
  - b) a polar organic solvent comprising from about 25% to about 75% by volume of said composition; and
  - c) a surfactant comprising from about 0.5% to about 20% by weight to volume of said composition;

to solubilize the wax in the specimen, and

a second container containing (1) an immunostaining reagent or (2) an aqueous wash solution comprising a detergent for removing residual dewaxing composition from said tissue specimen.

21. A composition for removing wax from a wax-embedded biological tissue specimen comprising:

- (a) at least one paraffin-solubilizing organic solvent selected from the group consisting of aromatic hydrocarbons, terpenes and isoparaffinic hydrocarbons, said paraffinic-solubilizing organic solvent comprising from about 25% to about 75% by volume of said composition;
- (b) at least one water soluble polar organic solvent, said water soluble polar organic solvent comprising from about 25% to about 75% by volume of said composition;
- (c) at least one water soluble surfactant, said water soluble surfactant comprising from about 0.5% to about 20% by weight to volume of said composition; which composition removes wax from the tissue specimen.

### THE REFERENCES

The prior art references relied on by the examiner are:

Gipp	4,530,781	Jul. 23, 1985
Stevens	5,124,062	Jun. 23, 1992

### THE REJECTION

Claims 2 and 4 through 21 stand rejected under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Gipp and Stevens.

### DELIBERATIONS

Our deliberations in this matter have included evaluation and review of the following materials:

- (1) the instant specification, including all of the claims on appeal;
- (2) the Appeal Brief (Paper No. 19);
- (3) the Examiner's Answer (Paper No. 20); and
- (4) the above-cited prior art references.

On consideration of the record, including the above-listed materials, we reverse the examiner's prior art rejection. We also recommend that the examiner reevaluate the patentability of applicants' composition claims in light of Stevens considered alone.

### THE EXAMINER'S REJECTION

In rejecting all of the appealed claims under 35 U.S.C. § 103, the examiner relies on the combined disclosures of Gipp and Stevens. According to the examiner, "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the surfactants of Stevens in the composition of Gipp" (Paper No. 20, page 5, last paragraph). The examiner argues that by modifying Gipp in this manner, per the teachings of Stevens, a person having ordinary skill would have arrived at the claimed invention. We disagree.

Gipp's invention relates to laundry pre-spotting compositions. More particularly, Gipp discloses metastable emulsion laundry pre-spotting compositions having excellent stain removal properties. Stevens discloses paint stripper and varnish remover compositions. Each reference, therefore, relates to a different field of endeavor, and we can find no apparent reason for applying the teachings of Stevens to modify Gipp's metastable pre-spotting composition in the manner proposed. The examiner's position to the contrary, notwithstanding, neither reference contains a suggestion to use what it discloses in combination with the disclosure in the other. In sum, the prior art does not suggest the desirability of the modification proposed by the examiner; the combination of references is improper; and the rejection of applicants' claims based on that combination cannot be sustained.

Even assuming arguendo that the combination were proper, and we hold that it is not, we would not sustain the examiner's rejection. This follows because Gipp does not disclose or suggest component (b) in claim 21, viz., "at least one water soluble polar organic solvent, said water soluble polar organic solvent comprising from about 25% to about 75% by volume of said composition" (emphasis added). In other words, even if it were obvious to employ the surfactants of Stevens in the composition of Gipp, a person having ordinary skill would not have arrived at applicants' claimed composition containing a relatively high amount of water-soluble polar organic solvent. Nor does Gipp or Stevens disclose or suggest a process for removing wax from a wax-embedded biological tissue specimen, as recited in claim 18, or a dewaxing kit for removing wax from a wax embedded biological tissue specimen, as recited in claim 20.

The rejection of claims 2 and 4 through 21 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Gipp and Stevens is reversed.

#### OTHER ISSUE

One further matter warrants attention.

On return of this application to the examining corps, we recommend that the examiner reevaluate the patentability of applicants' composition claims in light of Stevens considered alone. In this regard, we emphasize that (1) independent claim 21 is drawn to a composition, not to a process for removing wax from a wax-embedded biological tissue specimen or to a dewaxing kit, and (2) the "intended use" language in claim 21 does not constitute a claim limitation. The language "for removing wax from a wax-embedded biological tissue specimen" and "which composition removes wax from the tissue specimen" sets forth the intended use of applicants' composition but does not place a limitation on that composition or serve to distinguish that composition from the prior art. As stated in the Appeal Brief (Paper No. 19), page 5, last paragraph, "[a]pplicants acknowledge that a statement of intended purpose does not confer patentability on an otherwise unpatentable composition." See In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990) ("the discovery of a new property or use of previously known composition, even when that property and use are unobvious from the prior art, cannot impart patentability to claims to the known composition"); In re Pearson, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974) (court referred to terms in the claims which "merely set forth the intended use for, or a property inherent

in, an otherwise old composition ... such terms do not differentiate the claimed composition from those known to the prior art”).

Stevens discloses a paint stripper and varnish remover composition comprising (a) about 10% to about 60% by weight of a terpene compound, e.g., d-limonene; (b) about 10% to about 50% by weight of N-methylpyrrolidone, a highly polar, water-miscible solvent; and (c) about 2% to about 20% by weight of one or more terpene emulsifying surfactants. It appears to this merits panel that the Stevens composition bears a close relationship to the composition recited in claim 21. Consider, for example, that component (a) in claim 21 may be a terpene compound such as limonene. Consider also that, most preferably, the polar organic solvent recited in claim 21 (b) is miscible with water (Specification, page 7, lines 8 through 20). Compare the Stevens disclosure that N-methylpyrrolidone is a highly polar, water-miscible solvent (column 6, lines 10 and 11).

All in all, it would appear obvious, and well within the skill of the art, to select a relatively high amount of terpene compound and N-methylpyrrolidone within the framework of Stevens' disclosure, and thus to arrive at the subject matter sought to be patented in claim 21. Further, the paint stripper compositions of Stevens may include about 10% to about 60%, preferably about 20% to about 40% of a high flashpoint, high kauri-butanol solvent selected from the group consisting of polycarbonates (including ethylene carbonate, propylene carbonate, and butylene carbonate) and glycols and glycol ethers (column 8, lines 33 through 39). Glycols include, inter alia, ethylene glycol and propylene glycol (column 8, lines 52 and 53). In this regard, claim 21 (b) recites “at

least one" water soluble polar organic solvent, and dependent claim 7 mentions ethylene glycol and propylene glycol as exemplary of those solvents.

Based on the record presented, it appears that the examiner did not fully appreciate the relevance of Stevens' disclosure and its applicability to applicants' claimed invention. On return of this application to the examining corps, we recommend that the examiner (1) engage in a claim by claim analysis, and (2) reevaluate the patentability of applicants' claimed composition in light of Stevens considered alone and the foregoing remarks.

#### CONCLUSION

The examiner's decision rejecting claims 2 and 4 through 21 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Gipp and Stevens is reversed. On return of this application to the examining corps, we recommend that the examiner reevaluate the patentability of applicants' composition claims in light of Stevens considered alone.

#### REVERSED

Sherman D. Winters  
Administrative Patent Judge

William F. Smith  
Administrative Patent Judge

Donald E. Adams  
Administrative Patent Judge

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ELD

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